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EXAMINER

SNAPP, SANDRA S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3624

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/717,700

Applicant(s)

MINOT ET AL.

Examiner

Sandra Snapp

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004 and 10 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☒ Claim(s) 15 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Response to Amendment

Currently, claims 1-41 are pending in the application. This Office Action is in response to the Amendment filed 3-9-4 and the Supplemental Response filed on 3-10-4.

Priority

The Examiner acknowledges the Applicant's claim of priority to provisional application no. 60/166,431 which was filed 11/19/1999. Also, since one year from the filing of the provisional fell on a Sunday, (11/19/2000), it is acceptable that the current application was filed on Monday, 11/20/2000 while still maintaining priority to the provisional application.

Oath/Declaration

It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

Specification

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Also, the figure descriptions for Figs. 2 and 3 do not describe the figures themselves, they merely state that they provide additional details. The figure description should describe the type of figure shown in the drawings. M.P.E.P. 608.01(f).

Claim Objections

Claim 15 is objected to because in the fourth line from the bottom the phrase “a plurality ranked mortgage” appears to be awkward and grammatically incorrect. The Examiner suggests amending the phrase to read “a plurality *of* ranked mortgage. . . .”

Claim 17 is objected to because the phrase “providing information concerning *is* mortgage(s) and/or line(s)-of-credit” is grammatically incorrect. The Examiner suggests deleting the term “is” from the phrase. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-41 are indefinite because it is unclear to the Examiner how the recited steps are “marketing mortgage and/or credit services” as stated in the preamble to the claims. Clarification is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-21 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-15 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The Patent Office had taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001)(Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning. The Examiner acknowledges that the Applicant has actually stated “from said Internet connected user” and “presenting . . . via the Internet” in claim 1, however such does not meet the statutory requirement because, while it identifies the Internet, it does not specifically tie such Internet usage with the main crux of the claimed invention, which is the receiving and processing steps. In other words, while the user may actually be connected to the Internet, there is no positive recitation that identifies that such user is using the Internet to transmit the information over the Internet, or that such information is being received *via the Internet*. For example, the user could be connected to the Internet, reviewing the information, and using some other means to transmit their indications and information such as the telephone or fax. The claim language needs to identify that the Internet user is using the Internet to

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communicate. The examiner suggests amending the claim language for claim 1 to read something like, “receiving, *via the Internet*, from said Internet connected user, an indication . . .” or “processing *on a computer* said received indications and information”

The same issue applies to claims 15-21. While in claim 15, the language states, “so as to permit access, over the Internet,” it merely provides access, it does not mean that such access is actually being used.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Zandi patent (US 5,966,699).

The Zandi reference discloses a method for marketing mortgage and/or credit services over the Internet, comprising:

Selectively providing information concerning a plurality of mortgage and/or credit programs to an Internet-connected user (col. 3, lines 1-5 and col. 6, lines 1-22), receiving from the Internet-connected user, an indication of whether the user wishes to explore home financing options or home-equity loan options (col. 2, lines 15-31), receiving an indication of whether or not the user maintains an asset and/or brokerage account with a sponsor of the mortgage and/or credit services (col. 7, lines 54-61), receiving an indication of the user's residence (col. 8, lines

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1-12, while the Zandi patent does not specifically disclose the user's residence, the Examiner takes Official Notice that it is well known in the art that loan applications have the applicant's residence so as to properly identify the applicant and provide an address for future correspondence), receiving information concerning a property to be financed, the information including at least location, expected holding period, and use of the property (col. 9, lines 1-10), receiving information concerning the user's investments (col. 8, lines 1-12, while the Zandi patent does not specifically disclose the user's investments, the Examiner takes Official Notice that it is well known in the art for loan applications to contain investment information so as to provide an accurate picture of the persons net worth, obligations and their ability to repay the loan), processing the received indications and information to determine mortgage and/or credit options that correspond to the user's needs (col. 9, lines 10-18), and presenting the mortgage and/or credit options to the user via the Internet (col. 7, lines 8-13) (claim 1);

Selectively providing information concerning zero-down payment and conventional mortgage programs (col. 8, lines 1-12) (claim 2);

Selectively providing information concerning fixed-rate and adjustable-rate options (col. 8, lines 1-12);

Selectively generating pdf-format print files concerning selected mortgage and/or credit programs (col. 7, lines 3-7 and col. 6, lines 57-58) (claim 4);

Receiving an indication of whether the property is a single family home, condominium, multi-family residence, or commercial property (col. 8, lines 1-12, while the Zandi patent does not specifically disclose the type of property, the Examiner takes Official Notice that it is well known in the art for loan applications to contain the type of property so as to properly identify

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the property for which the money being borrowed is for and to provide accurate information about the property for which the loan is for) (claim 5);

Receiving information concerning the aggressiveness of the investments (col. 6, lines 39-58) (claim 6);

Receiving information concerning the expected rate-of-return on the investments (col. 7, lines 39-58, projections and analysis) (claim 7);

Receiving information concerning the value of non-retirement securities held by the user (col. 8, lines 1-12, while the Zandi patent does not specifically disclose the user's investments, the Examiner takes Official Notice that it is well known in the art for loan applications to contain investment information so as to provide an accurate picture of the persons net worth, obligations and their ability to repay the loan) (claim 8);

Receiving information concerning the portion of the non-retirement securities already pledged as collateral by the user (col. 6, lines 39-58 – projections and scenario analysis) (claim 9);

Providing a tabular comparison of at least three different down payment options (col. 6, lines 39-58) (claim 10);

Providing information concerning the costs/benefits of investing potential down payment funds (col. 6, lines 39-58 – projections and analysis) (claim 11);

Providing at least three options, each scored according to how well it meets the user's needs (col. 6, lines 39-58) (claim 12);

Selectively providing explanatory information concerning why the first option is the best option for the user's needs (col. 6, lines 39-58) (claim 13); and

Selectively providing a comparison of one or more system-recommended options with one or more user-selected options (col. 6, lines 39-58 – projections and analysis) (claim 14).

Claims 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Zandi patent (US 5,966,699) in view of the Atkins patent (US 5,875,437).

The Zandi reference discloses a method for marketing mortgage and/or credit services, over the Internet, to both financial consultants and retail customers, the method comprising:

Authenticating financial consultant users, so as to permit access, over the Internet, to selected consultant-exclusive resources (Atkins teaches the step of authenticating users in an electronic financial system in col. 5, line 53-67 – while the Zandi reference does not specifically disclose authenticating the users, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Zandi reference to include the teachings of Atkins so as to provide a secure system to all users thereof), selectively providing information concerning a plurality of mortgage and/or credit programs to any Internet-connected user who requests such information (Z, col. 3, lines 1-5 and col. 6, lines 1-22), receiving from the Internet-connected user, an indication of whether the user wishes to explore home financing options or home-equity loan options (Z, col. 2, lines 15-31), receiving an indication of the user's residence (Z, col. 8, lines 1-12, while the Zandi patent does not specifically disclose the user's residence, the Examiner takes Official Notice that it is well known in the art that loan applications have the applicant's residence so as to properly identify the applicant and provide an address for future correspondence), receiving information concerning a property to be financed, the information including at least location, expected holding period, and use of the property (Z, col. 9, lines 1-

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10), receiving information concerning investments (Z, col. 8, lines 1-12, while the Zandi patent does not specifically disclose the user's investments, the Examiner takes Official Notice that it is well known in the art for loan applications to contain investment information so as to provide an accurate picture of the persons net worth, obligations and their ability to repay the loan), presenting a plurality of ranked mortgage and/or credit options (Z, col. 9, lines 10-18), and presenting information concerning the financial consultant's clients (Z, col. 7, lines 8-13) (claim 15);

Providing information concerning in-process applications of the financial consultant's clients (Z, col. 5, lines 4-15) (claim 16);

Providing information concerning [is] mortgages and/or lines-of-credit of the financial consultant's clients (Z, col. 6, lines 39-58) (claim 17);

Allowing an Internet-connected retail customer to save information and/or indications provided by the customer (Z, col. 4, lines 7-14) (claim 19);

Allowing an Internet-connected retail customer to retrieve his/her previously-saved information and/or indications (Z, col. 4, lines 7-14) (claim 20); and

Allowing an Internet-connected financial consultant user to retrieve previously-saved information and/or indications of his/her client (Z, col. 4, lines 7-14) (claim 21).

Providing information concerning production credits of the financial consultant (col. 8, lines 1-10) (claim 18). While the Zandi patent may not specifically disclose the specific types of information received in claim 18, such information is considered by the Examiner to be non-functional descriptive language and as such is not patentably distinct over the cited Zandi reference. That is, the information itself does not alter the way the process steps function, they

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are still performed the same way, regardless of what the information is. Since the Zandi patent does disclose a system wherein information is received in the system, it renders the present application obvious.

Claims 22-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Zandi patent (US 5,966,699).

The Zandi reference discloses a computer-based system for marketing mortgage and/or credit services over the Internet, comprising:

http-responsive means for selectively providing information concerning a plurality of mortgage and/or credit programs to an Internet-connected user (col. 3, lines 1-5 and col. 6, lines 1-22, and http means is inherent in computer system as disclosed in Zandi), http-responsive means for receiving from the Internet-connected user, an indication of whether the user wishes to explore home financing options or home-equity loan options (col. 2, lines 15-31), http-responsive means for receiving an indication of whether or not the user maintains an asset and/or brokerage account with a sponsor of the mortgage and/or credit services (col. 7, lines 54-61), http-responsive means for receiving an indication of the user's residence (col. 8, lines 1-12, while the Zandi patent does not specifically disclose the user's residence, the Examiner takes Official Notice that it is well known in the art that loan applications have the applicant's residence so as to properly identify the applicant and provide an address for future correspondence), http-responsive means for receiving information concerning a property to be financed (col. 9, lines 1-10), http-responsive means for receiving information concerning the user's investments (col. 8, lines 1-12, while the Zandi patent does not specifically disclose the

user's investments, the Examiner takes Official Notice that it is well known in the art for loan applications to contain investment information so as to provide an accurate picture of the persons net worth, obligations and their ability to repay the loan), http-responsive means for processing the received indications and information to determine mortgage and/or credit options that correspond to the user's needs (col. 9, lines 10-18), and http-responsive means for presenting the mortgage and/or credit options to the user via the Internet (col. 7, lines 8-13) (claim 22);

Selectively providing information concerning zero-down payment and conventional mortgage programs (col. 8, lines 1-12) (claim 23);

Selectively providing information concerning fixed-rate and adjustable-rate options (col. 8, lines 1-12) (claim 24);

Selectively generating pdf-format print files concerning selected mortgage and/or credit programs (col. 7, lines 3-7 and col. 6, lines 57-58) (claim 25);

Receiving an indication of whether the property is a single family home, condominium, multi-family residence, or commercial property (col. 8, lines 1-12, while the Zandi patent does not specifically disclose the type of property, the Examiner takes Official Notice that it is well known in the art for loan applications to contain the type of property so as to properly identify the property for which the money being borrowed is for and to provide accurate information about the property for which the loan is for) (claim 26);

Receiving information concerning the expected rate-of-return on the investments over the holding period (col. 7, lines 39-58, projection and analysis) (claim 27);

Receiving information concerning the value of non-retirement securities held by the user (col. 8, lines 1-12, while the Zandi patent does not specifically disclose the user's investments,

the Examiner takes Official Notice that it is well known in the art for loan applications to contain investment information so as to provide an accurate picture of the persons net worth, obligations and their ability to repay the loan) (claim 28);

Receiving information concerning the portion of the non-retirement securities already pledged as collateral by the user (col. 6, lines 39-58 – projection and analysis) (claim 29);

Providing a tabular comparison of at least three different down payment options (col. 6, lines 39-58) (claim 30);

Providing information concerning the costs/benefits of investing potential down payment funds (col. 6, lines 39-58) (claim 31);

Providing at least three options, each scored according to how well it meets the user's needs (col. 6, lines 39-58) (claim 32);

Selectively providing explanatory information concerning why the first option is the best option for the user's needs (col. 6, lines 39-58) (claim 33); and

Selectively providing a comparison of one or more system-recommended options with one or more user-selected options (col. 6, lines 39-58) (claim 34).

Claims 35-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Zandi patent (US 5,966,699) in view of the Atkins patent (US 5,875,437).

The Zandi reference discloses a computer-based system for marketing mortgage and/or credit services, over the Internet, to both financial consultants and retail customers, the method comprising:

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Means for identifying certain Internet-connected users as financial consultants, thus enabling the identified users access, over the Internet, to selected consultant-exclusive resources (Atkins teaches the step of authenticating users in an electronic financial system in col. 5, line 53-67 – while the Zandi reference does not specifically disclose authenticating the users, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Zandi reference to include the teachings of Atkins so as to provide a secure system to all users thereof), means for selectively providing information concerning a plurality of mortgage and/or credit programs to any Internet-connected user who requests such information (Z, col. 3, lines 1-5 and col. 6, lines 1-22), means for receiving from the Internet-connected user, an indication of whether the user wishes to explore home financing options or home-equity loan options (Z, col. 2, lines 15-31), means for receiving information concerning a property to be financed, the information including at least location, expected holding period, and use of the property (Z, col. 9, lines 1-10), means for receiving information concerning investments (col. 8, lines 1-12, while the Zandi patent does not specifically disclose the user's investments, the Examiner takes Official Notice that it is well known in the art for loan applications to contain investment information so as to provide an accurate picture of the persons net worth, obligations and their ability to repay the loan), means for presenting a plurality of ranked mortgage and/or credit options (Z, col. 9, lines 10-18), and means for presenting information concerning the financial consultant's clients (Z, col. 7, lines 8-13) (claim 35);

Means for providing information concerning in-process applications of the financial consultant's clients (Z, col. 5, lines 4-15) (claim 36);

Means for providing information concerning mortgages and/or lines-of-credit of the financial consultant's clients (Z, col. 6, lines 39-58) (claim 37);

Session storage means for allowing an Internet-connected retail customer to save information and/or indications provided by the customer during a session with the system (Z, col. 4, lines 7-14) (claim 39);

Session retrieval means for allowing an Internet-connected retail customer to retrieve his/her previously-saved information and/or indications (Z, col. 4, lines 7-14) (claim 40); and

Client session retrieval means for allowing an Internet-connected financial consultant user to retrieve previously-saved information and/or indications of his/her client (Z, col. 4, lines 7-14) (claim 41); and

Means for providing information concerning production credits of the financial consultant (Z, col. 8, lines 1-10) (claim 38). While the Zandi patent may not specifically disclose the specific types of information received in claim 18, such information is considered by the Examiner to be non-functional descriptive language and as such is not patentably distinct over the cited Zandi reference. That is, the information itself does not alter the way the process steps function, they are still performed the same way, regardless of what the information is. Since the Zandi patent does disclose a system wherein information is received in the system, it renders the present application obvious.

Response to Arguments

Applicant's arguments with respect to claims 1-41 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Higgins, Walker et al., McClelland et al., Dykstra et al. Hartnett, Leon et al., Lawlor et al., Fraser et al., Davidson, Lockwood, Larche et al., Libman, Melchione et al., Libman, Oppenheimer, Atkins, Salmon et al., Dykstra et al., Tavor et al., Koleszar et al., Cullens and Berry patents and applications are all directed to various types of electronic financial systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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